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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,174	07/28/2000	Barry C. Muffoletto	04645.0416	2996

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EXAMINER

MCNEIL, JENNIFER C

ART UNIT	PAPER NUMBER
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1775

12

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 12

Application Number: 09/628,174
Filing Date: July 28, 2000
Appellant(s): MUFFOLETTO ET AL.

Martin Linihan
For Appellant

EXAMINER'S ANSWER

MAILED
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GROUP 1700

This is in response to the appeal brief filed May 3, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 6 and 7 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

5,098,485

EVANS

03-1992

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6 and 7 rejected under 35 U.S.C. 102(b) as being anticipated by Evans (US 5,098,485).

Evans teaches a metal substrate with a native oxide thereon. Atoms/ions of metals are deposited on the native oxide layer (col. 2, lines 24-60). After the atoms/ions are applied, the metals and native oxide are subjected to an elevated temperature for a time period effective to incorporate the selected atoms/ions into the native oxide film and to change the native oxide film from an electrical insulator to an electrical conductor.

(11) Response to Argument

Appellant states that the instant invention advantageously does not require the heat treatment disclosed by Evans to incorporate ions into the oxide layer to increase the electrical conductivity thereof. Appellant states that the ions of the instant invention are deposited by low temperature arc vapor deposition, as claimed. Regarding this method limitation, "[E]ven though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." (*In re Thorpe*,

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227 USPQ 964, 966). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product, (*In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983), MPEP §2113). It is the position of the Examiner that the final product produced by the method limitations in the article claims would be commensurate with the article taught by Evans.

Appellant argues that this limitation should be given patentable weight because the claims are not in the form of the product-by-process claims of *In re Thorpe*, but are hybrid type claims in the form of *In re Luck*, 177 USPQ 523 (CCPA 1973). It is the examiner's position that the instant claims are commensurate with the types of claims of *Thorpe*. Whether the claims are considered a product-by-process, or a hybrid of a product-by-process, the article is still being defined in terms of the process by which it is made. Therefore, the evaluations of *Thorpe* and *Luck* are considered to apply.

Applicant states that in *Luck* the court clearly held that process limitations are to be considered in a product claim to patentably distinguish the product over the prior art. As noted in *Luck*, while the Board agreed that process limitations *could* result in a difference in the coated article, there was no criticality nor rebuttal evidence presented which distinguished the article over the prior art, even with patentable weight given to the process limitations. In light of this, even with patentable weight given to the process limitation of the instant claims, there has been no evidence provided that distinguishes the article made by the process of the instant claims over that of the prior art. In the instant application, appellant's invention is indeed deposited in a different manner. However, both the instant invention and the invention of Evans have a final product that is considered structurally and functionally commensurate. Appellant has provided no comparative evidence that the manner in which their invention is formed distinguishes over that of Evans. Appellant states in the specification, page 2, second

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full paragraph, that the new and improved method provides control over the density and depth of the material introduced, and improves the quality of the treated surface. Again, applicant has provided no evidence to support this statement. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Jennifer McNeil
Examiner
Art Unit 1775


DEBORAH JONES
SUPERVISORY PATENT EXAMINER

JCM
June 13, 2003



Conferees


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